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the light diffusing layer is formed by dispersing resinous beads and a fine inorganic filler into a binder, and

the fine inorganic filler is colloidal silica having an average particle diameter that is in a range of 5 nanometers to 50 nanometers.

REMARKS/ARGUMENTS

Claims 1-7 are pending and at issue. All claims stand rejected under one of two obviousness rejections, one based on Kitamura et al. in combination with JP 07-005305, the other on Kitamura et al. in combination with JP 8-227005. The Applicant has carefully considered these rejections and respectfully traverses for the reasons now outlined.

Claims 1, 4, and 7 are the only independent claims. Claims 1-3 and 7 stand rejected based on Kitamura et al. in combination with JP 07-005305. Turning to claim 1, the Office Action acknowledges that Kitamura et al. does not disclose an inorganic filler made of colloidal silica, as claimed. The Office Action points to JP 07-005305 for that teaching. In so doing, however, the Office Action also acknowledges that, in fact, JP 07-005305 does not teach or disclose colloidal silica. (Clearly, the obviousness rejection is improper, as neither reference teaches an inorganic filler that is "colloidal silica," as recited in claim 1.) X

The Examiner's attention is drawn to the computer generated translation of the JP 07-005305 document that has been submitted in a contemporaneously-filed PTO-1449. The translation was obtained from the WIPO Intellectual Property Digital Library website and describes only titanium dioxide, talc, alumina and silica for its mineral filler. (See, paragraph [0013]). The document makes no mention of a colloidal silica. Thus, the Office Action's suggestion that colloidal silica would have been an obvious substitute is nothing more than impermissible hindsight review. The Office Action points to nothing in the prior art that teaches or suggests using colloidal silica.

The Office Action falls into the trap of using the pending application as the source of the required substitutes. This is not allowed. To establish *prima facie* obviousness, all claimed subject matter must be taught or suggested by the prior art. MPEP §2143.03, citing

In re Royka, 490 F.2d 981, 984 (CCPA 1974). As instructed many times, both the suggestion to try and the expectation of success must be found in the prior art, not in the applicant's disclosure. Amgen Inc. v. Chugai Pharmaceutical Co. Ltd., 927 F.2d 1200, 1207 (Fed. Cir. 1991), citing In re Dow Chemical Co., 837 F.2d 469, 475 (Fed. Cir. 1988). The Office Action points to nothing in the prior art as suggesting the use of colloidal silica. As such, *prima facie* obviousness has not been established.

Not only is there no teaching of colloidal silica in the prior art, there would be no suggestion to substitute the filler of the JP 07-005305 with the claimed subject matter. As amended, claim 1 recites an inorganic filler that is colloidal silica "having an average particle diameter that is in a range of 5 nanometers to 50 nanometers." The amendment clarifies the miniscule size of colloidal particles. In contrast, JP 07-005305 discloses an average particle diameter of between 0.1 to 5 μ m. (See, paragraph [0013]). The range shows that the prior art filler is not a colloidal silica and, *a fortiori*, not a colloidal silica "having an average particle diameter that is in a range of 5 nanometers to 50 nanometers." There is nothing in the prior art that teaches or suggests using the claimed colloidal silica. The rejection of claim 1 and claims 2-3, by implication, are traversed. Claims 1-3 are in condition for allowance.

Regarding the rejection of claim 7, that claim has been amended above to recite an inorganic filler "that is colloidal silica having an average particle diameter that is in a range of 5 nanometers to 50 nanometers." For the reasons stated above with respect to claim 1, the rejection of claim 7 is also traversed. Claim 7 is in condition for allowance.

Claim 4 and dependent claims 5 and 6 stand rejected based on the combination of Kitamura, JP 07-005305, and JP 8-227005. Claim 4 has been amended above to further clarify the term colloidal silica. It has been established above that the first two of these references do not teach an inorganic filler that is "colloidal silica." It has also been established that these two references fail to teach an inorganic filler that is "colloidal silica having an average particle diameter that is in a range of 5 nanometers to 50 nanometers." The question now becomes: "Does JP 8-227005 teach this claimed subject matter?" Clearly, it does not.

JP 8-227005 does teach a light control sheet that in an embodiment describes a sticking preventive layer 20 formed of beads. As with the JP 07-005305 document, an English translation of JP 8-227005 obtained from the WIPO Intellectual Property Digital Library website has been submitted in a contemporaneously-filed PTO-1449. That JP 8-227005 document describes only polymethylmethacrylate (PMMA) as being used for its bead material. (See, paragraph [0023]). It does not teach or suggest using colloidal silica. Furthermore, the bead size taught is limited to .1 - 50 μm . (See, paragraph [0027]). Therefore, the document also does not teach "colloidal silica having an average particle diameter that is in a range of 5 nanometers to 50 nanometers," as recited in claim 4. Claim 4 is in condition for allowance and the rejection is traversed.

In sum, all of claims 1-7 are in condition for allowance and a timely indication of the same is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

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Respectfully submitted,

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Version With Markings to Show Changes Made

In the Claims

Please amend claims 1, 2, 4, 5, and 7 as follows:

1. (Amended) A light diffusing sheet comprising:

a transparent base sheet; and

a light diffusing layer provided on a front surface side of the base sheet, wherein

the light diffusing layer is formed by dispersing resinous beads and a fine inorganic filler into a binder, and

the fine inorganic filler is colloidal silica having an average particle diameter that is in a range of 5 nanometers to 50 nanometers.

2. (Amended) The light diffusing sheet of Claim 1, wherein the resinous beads of the light diffusing layer have an averaged particle diameter of 1 micrometer to 50 micrometers [and the fine inorganic filler of the light diffusing layer has an averaged particle diameter of not smaller than 5 nanometers and smaller than 1 micrometer].

4. (Amended) A light diffusing sheet comprising:

a transparent base sheet;

a light diffusing layer provided on a front surface side of the base sheet; and

a sticking-proof layer provided on a rear surface side of the base sheet, wherein

the sticking-proof layer is formed by dispersing resinous beads and a fine inorganic filler into a binder, and

the fine inorganic filler is colloidal silica having an average particle diameter that is in a range of 5 nanometers to 50 nanometers.

5. (Amended) The light diffusing sheet of Claim 4, wherein the resinous beads of the sticking-proof layer has an averaged particle diameter of 1 micrometer to 50 micrometers [and the fine inorganic filler of the sticking-proof layer has an averaged particle diameter of not smaller than 5 nanometers and smaller than 1 micrometer].

7. (Amended) A backlight unit comprising:

a lamp;

a light guiding plate disposed laterally of the lamp for guiding light rays emitted from the lamp to a front surface side; and

a light diffusing sheet [according to any of Claims 1 to 6] disposed on a front surface side of the light guiding plate, wherein,

said light diffusing sheet comprises;

a transparent base sheet; and

a light diffusing layer provided on a front surface side of the base sheet, wherein

the light diffusing layer is formed by dispersing resinous beads and a fine inorganic filler into a binder, and

the fine inorganic filler is colloidal silica having an average particle diameter that is in a range of 5 nanometers to 50 nanometers.